

TRANSLATION

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 0000055039	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/EP2004/012335	International filing date (<i>day/month/year</i>) 30.10.2004	Priority date (<i>day/month/year</i>) 03.11.2003
International Patent Classification (IPC) or national classification and IPC C08G18/10, C08G18/08, C08G18/24, C08G18/22		
Applicant BASF AKTIENGESELLSCHAFT		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of <u>5</u> sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising: a. <input type="checkbox"/> (<i>sent to the applicant and to the International Bureau</i>) a total of _____ sheets, as follows: <input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions). <input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box. b. <input type="checkbox"/> (<i>sent to the International Bureau only</i>) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).
4. This report contains indications relating to the following items: <input checked="" type="checkbox"/> Box No. I Basis of the report <input type="checkbox"/> Box No. II Priority <input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability <input type="checkbox"/> Box No. IV Lack of unity of invention <input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement <input type="checkbox"/> Box No. VI Certain documents cited <input type="checkbox"/> Box No. VII Certain defects in the international application <input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/012335

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-17 _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- nos. 1-17 _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* _____ received by this Authority on _____
- nos.* _____ received by this Authority on _____
- ☒ the drawings:
- sheets 1 _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/012335

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	1-15, 17	YES
	Claims	16	NO
Inventive step (IS)	Claims	1-15, 17	YES
	Claims	16	NO
Industrial applicability (IA)	Claims	1-17	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
Reference is made to the following document:			
D1: EP-A-1 253 159 (cited in the application).			
1. <u>Novelty (PCT Article 33(2)) and inventive step (PCT Article 33(3))</u>			
<p>Document D1 discloses <u>prepolymers containing isocyanate groups</u> with a residual diisocyanate content smaller than 0.1 % by weight, which are based on 2,4-TDI and/or 2,6-TDI as asymmetrical diisocyanate and a polyetherpolyol, and contain ≥ 80 % by weight of ABA structures having a perfect prepolymer structure.</p> <p>(D1: the NCO prepolymer contains 80 % by weight perfect prepolymer structures, page 3, lines 13-21 and lines 47-58; prepolymer on the basis of 2,4-TDI and/or 2,6-TDI and polyetherpolyols with a residual diisocyanate content of < 0.1 % by weight, page 4, lines 15-24 and Table 1, prepolymer 5).</p> <p>Consequently, the subject matter of product claim 16, which relates to prepolymers containing isocyanate</p>			

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/012335

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

groups, is anticipated by document D1 and hence the application does not satisfy the requirement of PCT Article 33(2).

The applicant is therefore invited to delimit the above claim with respect to document D1. Should it not be possible to do so, he is requested to demonstrate that the feature used to substantiate novelty, which is not anticipated by the prior art, is not obvious and directly connected to the problem to be solved.

Only if the above conditions are met can this feature contribute to an inventive step relative to document D1, in line with the requirements of PCT Article 33(2) and (3).

2. Industrial applicability (PCT Article 33(4))

The application relates to isocyanate-containing prepolymers for the production of polyurethane and is therefore industrially applicable.

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Clarity (PCT Article 6)

1. In the interest of clarity (PCT Article 6), the features in claim **13** introduced by "such as" should be deleted since they do not restrict the scope of the claim. These features could be made the subject of dependent claims.

Regarding claim **13** it is further unclear how the group R_2 in the compound formula (I) of claim **13** can refer to "nothing", since in that case the result would be a triple-bonded, that is unstable, C atom.

2. As regards claim **14**, it is unclear to which C atom in formula (I) the carbon atom (C1) of the cited functionalized organic carboxylic acids should correspond.